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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,976	08/21/2001	Stephen B. Auger	67233-011	3525

7590 11/04/2004

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/932,976

Applicant(s)

AUGER, STEPHEN B.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 121-239 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 121-185, 190-222, 224, 225 and 230-239 is/are rejected.
- 7) ☐ Claim(s) 186-189, 223, 226-229 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Applicant's amendment filed on 9/2/04 as been entered and applicant's remarks carefully considered.

The pending claims are claims 121-139. The cancellation of all of the pending claims has mooted the rejections of record.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 121-178 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an oxidizing solution wherein the solution includes sodium hydroxide, does not reasonably provide enablement for an oxidizing agent which is sodium hydroxide. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention these claims.

There is no basis in the disclosure for the process as claimed wherein the component (b) as now claimed, the oxidizing agent is sodium hydroxide. Applicant has not pointed to basis for this insertion and the examiner cannot find it in the specification. The entire specification is directed to an oxidizing agent being a peroxide. Applicant has provided 25 examples of the invention. All use hydrogen peroxide or sodium peroxide as the oxidizing agent. Regarding sodium hydroxide, page 6 line 21 states, "The oxygen

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source may include a hydroxide such as sodium hydroxide.” The antecedent basis for “oxygen source” in that sentence is “a peroxide” on line 20. In other words, the composition which has a peroxide as the oxygen source may further include sodium hydroxide. Sodium hydroxide is not the oxidizing agent. Applicant states in several places that the oxygen source is preferably a peroxide. See page 3 line 22, page 6 line 20, page 9 lines 18-20, page 13 lines 21-24, page 15 lines 18-19.

### ***Response to Arguments***

It appears that the examiner and applicant have a disagreement as to the meaning of the paragraph on page 6 lines 20-24 wherein applicant specifically lists the preferred oxygen sources for use in the inventive method as being peroxides and then states that the oxygen source may **include** a hydroxide. The only oxygen sources listed by applicant are peroxides; applicant does not call hydroxides oxygen sources or oxidizing agents because they are not oxidizing agents. “Words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) The MPEP at 2111.01 states, “Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) (“In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.”). In this

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instance, the ordinary and customary meaning of oxidizing agent is given in Grant and Hackh's chemical Dictionary, page 416 as, "A substance that (1) yields oxygen readily, (2) removes hydrogen from a compound, or (3) attracts negative electrons; e.g.: the common oxidizing agents are  $O_2$ ,  $O_3$ ,  $KmnO_4$ ,  $K_2Cr_2O_7$ ,  $KClO_3$ ,  $HNO_3$ ,  $H_2O_2$ ." Note that hydroxides are not listed. Since they are one of the most common of chemicals, they would most certainly be included in a definition of an oxidizing agent if indeed a hydroxide were commonly known as an oxidizing agent. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Applicant has not done so in this instance.

Claims 122,160,181,221 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot find basis in the specification for "tannic acid" and applicant has not pointed to the basis in the response.

Claims 121-138,140-156,158-176,178,200-216,218 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a

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process of treating wood, does not reasonably provide enablement for any process steps for treating any other substrate. For example, how would applicant treat hair? Would the process of the invention adequately dye a textile fiber or a mass of plastic? The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 133,152,171,192, 212 and 232 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above claims recite the limitation "manganese (II) chloride" while there is no antecedent basis for the limitation of "manganese (II) chloride" in the independent claims.

Claims 198 and 238 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are rejected as being redundant as claiming the same subject matter as the claims from which they depend.

Claims 197,199, 237 and 239 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention. These claims are outside of the scope of the independent claims.

Claims 137, 175, 196, 215 and 236 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are outside of the scope of the independent claims wherein the claimed metals of the metal salts do not include iron.

### ***Double Patenting***

Applicant is advised that should claims 179 and 219 be found allowable, claims 198 and 238 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 179,180,190,193,194,197,198,200, 201,210,211,213,214, 216,217,219, 220,230,231,233,234,237 and 238 are rejected under 35 U.S.C. 102(b) as being anticipated by Dombay, US 3,554,785.

Example 5 discloses treating wood with a first composition containing potassium permanganate, wherein the composition is diluted with water. After drying the wood, the wood is treated with a hypochlorite composition and then with a solution of hydrogen peroxide. Therefore, the process as claimed is anticipated.

Claims 179,180,190,193,194,197,198,200,201,210,211,213,214, 216,217,219, 220,230,231,233,234,237 and 238 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsushita, JP 60-250906. See English translation.

A process of bleaching wood to impart a light color thereto is taught whereby an aqueous solution of a metal salt selected from cobalt or nickel nitrate, potassium carbonate, calcium carbonate or sodium carbonate is applied to a board, the board is cured and then an aqueous solution of hydrogen peroxide is applied. The metal salt is applied to activate the hydrogen peroxide, which is a reaction process. See the English translation, pages 1-4. Accordingly when potassium carbonate is used, Matsushita anticipates the claims.

Claims 121,122,126,132,134,135,138,139,141,145,151,153,154,156,157 159,164, 170,172,173,176,177,179,180,185,191,193,194,197,198,200,201,05,211,213, 214, 216,217,219,220,225,231,233,234,238 are rejected under 35 U.S.C. 102(b) as



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being anticipated by Matsushita Elec Works, JP 61-23704. Treatment of wood with aqueous solutions comprising sodium hydroxide or potassium hydroxide and hydrogen peroxide and also a solution (0.5-2% solution) of magnesium sulfate is disclosed thus anticipating the above claims.

Claims 200, 201, 205, 208-211, 213 and 214 are rejected under 35 U.S.C. 102(b) as being anticipated by Lorenz et al., US 5,525,123. Lorenz et al. claim a process for treating hair wherein 0.001 to about 2.5% by weight of a metal salt solution is mixed with peroxide solution and used to brighten and color hair. The peroxide solution and metal salt solution are mixed, and thus applied simultaneously. The metal salts include potassium iodide, magnesium acetate, potassium bichromate, cerium sulfate, cerium chloride and vanadium sulfate.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 179, 180, 182, 184, 191-195, 297, 198, 200-202, 204, 211-217, 219, 220, 224, 231-235, 237 and 238 rejected under 35 U.S.C. 103(a) as being unpatentable over Bures, CS145495. See English translation. A process of staining any kind of wood is

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taught (p 7 last paragraph) whereby three solutions are applied sequentially to wood. Both the first and last solutions contain metal salts and/or bleaching agents. Page three states that the first step is to treat the wood with at least one salt or at least one peroxide oxidizing agent, and the third step treats with at least one complex of copper, **silver**, nickel or permanganate. Page 5 first paragraph states that the solution of the first step uses a mixture of salts, including alkaline metals and peroxides, hyperoxides, or peracids. The latter three are all oxidizing agents. The wood may be dried between applications (p 7 second paragraph). Example 1 on page 8 discloses treating dried birch with an aqueous solution comprising **hydrogen peroxide** and then with an aqueous solution of **silver nitrate**. In example 2 on page 9, both the first and third solutions contain both bleach and a metal salt; the first solution contains the bleach ammonium persulfate and the metal salt, copper sulfate in an aqueous alcohol solution; the second solution contains **potassium** permanganate, which is both a bleach and an oxidizing agent, and two other metal salts, **zinc sulfate** and sodium aluminate. See also claim 1 on page 11 which claims treating wood with a **peroxide** or peracid in a mixed solvent in a first step, and treating with a compound of **silver**, copper, nickel or permanganate (bleaching agent) in the last step.

Bures differs from the instant claims in that the sequence of applying the metal salt and the peroxide is not the same as claimed, and, regarding instant claim 219 and its dependent claims, Bures uses three steps.

The subject matter would have been obvious to the skilled artisan because Bures teaches a process in which the stated metal salts and peroxide are brought to react on

a wooden substrate in order to produce a change in color and that is what applicant is doing. It is the same process whether the peroxide solution is the first or second solution because the reaction of the peroxide with the metal salt is what causes the color pigment to form. Accordingly, absent evidence to the contrary, patentee has taken two steps from the process of Bures and uses them to form a coloring on wood. It is known that oxidizing metal salts forms colored pigments, and that is what both applicant and Bures are doing. It is obvious to perform an operation in two steps that has been performed in three steps in the prior art in order to save time and money.

### ***Claim Objections***

Claims 133,152,171,192,212,232 objected to because of the following informalities: "Cerium(III)perchlorate" is named twice. Appropriate correction is required.

### ***Allowable Subject Matter***

Claims 186-189,223, 226-229 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-W and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 2, 2004



Margaret Einsmann  
Primary Examiner  
Art Unit 1751